

REMARKS

In the Claims:

Claims 1-18 are pending in this application. Claims 4, 5, 14-16, and 18 have been withdrawn from prosecution based on a restriction requirement. Claims 1-3, 6-13, and 17 were rejected by the Examiner. Claims 1, 12, and 17 are amended. Support for the new claims and amendments are found throughout the specification and the drawings. The amendment has been made to further clarify the operation of the laser light located on the spindle of the tool. No new search is required because the additional limitations and the new claim should have been encompassed by the previous search. For example, the previous search uncovered the Peot and Kelly references, which both disclose the operation of a laser located in the rotating spindle of a tool that is powered from a power source in the spindle. In view of the following amendments and remarks, Applicants respectfully request reconsideration of the application.

I. Prior Art under 35 U.S.C. § 102(e)

Applicants submit that U.S. Published application 2002/0170404, now U.S. patent number 6,855,107, to Peot ("Peot") is only prior art to the current application by virtue of 35 U.S.C. § 102(e) because the current application was filed on January 25, 2002, which is less than one year after the Peot application was filed on May 18, 2001. The current application has been assigned to One World Technologies, Limited (found at reel 012536, frame 0324) with the assignment being recorded on the filing date. The Peot patent was assigned to One World Technologies, Company (found at reel 012183, frame 0001) and later assigned to One World Technologies, Limited (found at reel 014066, frame 0731). Because Peot is only 102(e) prior art to the current application, and both references have been assigned to the same entity, the Peot reference cannot be used to preclude patentability of the current application. 35 U.S.C. §103(c). The Applicant respectfully requests that the Examiner cancel any rejections that are made against the current claims based on the Peot reference. In discussing the substantive

rejections of the claims under 35 U.S.C. § 103(a), the Applicants will not discuss the Peot reference because it cannot serve to preclude patentability the current application.

II. Rejections under 35 U.S.C. § 103

Claims 1, 2, 6, 8, 13, and 17 were rejected under 35 U.S.C. § 103(a) as being obvious U.S. patent number 5,862,727 to Kelly ("Kelly") in view of PCT application number WO 99/02310 to Osenbruggen ("Osenbruggen") and U.S. patent number 6,153,957 to Takano ("Takano").

Obviousness requires some suggestion or motivation to combine the references. One skilled in the art would not have been motivated to combine the Kelly reference with the Osenbruggen and Takano references. Kelly discloses a laser that is mounted on the spindle, or rotor, of the saw and is powered from a battery located on the rotor. Osenbruggen discloses a plurality of embodiments that feature tools with lights, although none of the lights are located on a rotating component of the tool. Takano discloses the use of a generator to provide power to various external loads. The power produced by the generator is available from windings on the stator; therefore Takano does not disclose any structure for generating power for use with components that are located on the rotor of the generator. Because Kelly discloses the use of a laser light on the rotor of a tool and Osenbruggen and Takano only disclose lights that are located on the non-rotating portion of the tool, and the generation of electrical power available from the stator of the generator, respectively, one of ordinary skill in the art would not have combined the teachings of Kelly with Osenbruggen and Takano because they are directed to different types of lights and circuits to power the lights. Because there is no motivation to modify Osenbruggen and Takano to power a laser on the rotor, and it would require dramatic modification of these references to power a laser located on a rotor, the combination of Osenbruggen and Takano with Kelly is improper.

Even if the references could be properly combined, the combination does not disclose all of the limitations of the independent claims. Amended claim 1 requires "a laser light disposed at least in part within the housing; and a circuit electrically connected to the laser for providing power to the laser, the circuit providing power from a voltage source that includes a portion secured to the non-rotating portion of the saw, wherein electric current to power the laser light is generated on the spindle." While

Kelly discloses a laser light rotatably mounted to the spindle of a tool, neither these references, nor Osenbruggen and Takano disclose a voltage source that includes a portion secured to the non-rotating portion of the saw to provide power to the laser with the electric current to power laser being generated on the spindle. The light in Kelly is powered from batteries located in the rotor. As discussed above, the lights in Osenbruggen are each located on a non-rotating portion of a tool, and the power generated by the generator in Takano provides power to connections on the stator of the generator. Takano does not disclose the generation of current for use with a load on the spindle or the rotor. Because the cited references do not disclose all of the limitations of independent claim 1, Applicants respectfully request that the obviousness rejection of claims 1, 2, and 6 be withdrawn.

Independent claim 8 requires "a laser arbor having a housing secured to the spindle for rotation with the blade; a light source disposed in the housing ... a generator electrically connected to the light source ... wherein the generator includes a rotor associated with and rotated with the housing and a stator secured adjacent to the housing, the rotor being rotated by the motor relative to the stator for generating electrical power in the rotor for the light source." Similarly, independent claim 17 requires "a laser arbor having a housing secured to the spindle for rotation with the blade; a light source disposed in the housing ... a generator electrically connected to the light source for providing power produced in the spindle to the light source, the generator having a permanent magnet secured to a fixed guard and a coil rotated by the spindle." Both of these claims require the generation of power in the rotor (or spindle) to power the light source that rotates with the spindle. Therefore, as discussed above with respect to claim 1, none of the references cited alone or in combination disclose these limitations. Therefore, Applicants respectfully request that the obviousness rejection of claims 8, 13, and 17 be withdrawn.

Claims 3, 7, and 9-12 were rejected under 35 U.S.C. § 103(a) as being obvious over Kelly in view of Osenbruggen and Takano in further view of U.S. patent number 3,555,325 to Inariba ("Inariba"). As discussed above, Kelly in view of Osenbruggen and Takano do not disclose all of the limitations of claims 1 and 8. Furthermore, the additional combination of Inariba is improper because Inariba is directed to a

synchronous motor with an external AC current being applied to the rotor, not a generator that produces current on the rotor. One of skill in the art would not have looked to AC synchronous motors when designing a power tool with a light on a rotor of a tool powered by current generated on the rotor.

Even if all of the above references could be properly combined, they do not disclose all of the limitations of claims 3, 7, and 9-12. Furthermore, the addition of Inariba still does not cause the combination of references cited by the Examiner to disclose all of the limitations of independent claims 1 and 8, let alone dependent claims 3, 7, and 9-12. Specifically, because Inariba is directed to the design for a synchronous AC motor, which operates with an AC excitation current applied to the rotor windings (4), the Inariba operates oppositely from a generator that produces current in rotor windings when the rotor is rotated by a prime mover. Because the combination of references cited by the Examiner does not disclose all of the limitations of independent claims 1 and 8, they cannot render claims 3, 7, and 9-12 obvious. Therefore, Applicants respectfully request that the rejections of claims 3, 7, and 9-12 be withdrawn.

The Applicants note that the Examiner also cited U.S. patent number 5,128,840 to Seki ("Seki") and U.S. patent number 5,857,762 to Schwaller ("Schwaller") in the "Response to Amendment" section found on page 5 of the office action. The Applicants note that both of these references disclose the use of generators to replace the use of batteries on components, the references both disclose the generation of current in the stator of the generator to provide current for loads that do not rotate with the rotor of the generator. Therefore, these references do not serve to anticipate or render obvious the amended claims.


SUMMARY

Claims 1-3, 6-13 and 17 are patentable. Applicants respectfully request the Examiner grant early allowance of this application. The Examiner is invited to contact the undersigned attorney for the Applicants via telephone if such communication would expedite this application.

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Respectfully submitted,

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